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Eiichi Kito

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EXAMINER

LOVEL, KIMBERLY M

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,395

Applicant(s)

KITO, EIICHI

Examiner

Kimberly Lovel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed 22 June 2006.
2. Claims 1-22 are pending in this application. Claims 1, 11 and 15 are independent. In the Amendment filed 22 June 2006, claims 20-22 have been added. This action is made Final.
3. The rejections of claims 1-19 as being anticipated by US-PGPub 2003/0009569 to McIntyre et al have been maintained and the rejections of claims 20-21 as being as being unpatentable over US PGPub 20030009569 to McIntyre et al in view of US Patent No 7,016,868 to McIntyre et al and of claim 22 as being anticipated by US-PGPub 2003/0009569 to McIntyre et al have been added as necessitated by the amendment.

Drawings

4. The objections to the drawings have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-19 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by US PGPub 20030009569 to McIntyre et al (hereafter McIntyre et al).

Referring to claim 1, McIntyre et al disclose an image management device (see abstract), comprising:

an image storage unit [removable storage drive 14 which is connected to user computer 10] which accumulates and stores a plurality of photographic image data sets [digital still images] (see [0053], lines 13-26);

an image receiving unit [service provider 80] which receives the plurality of photographic image data sets from customers [user low resolution image collection] and stores the plurality of photographic image data sets (see [0054], lines 7-12), along with customer data related to the customers, in a state accessible to the customers (see [0054], lines 13-21);

an image storage expiration determining unit [service provider 80] which determines whether to expire from storage the plurality of photographic image data sets accumulated and stored in the image storage unit (see [0068], lines 22-37 – the service

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provider decides whether the ordering period has expired, and if it has, the service provider then expires the high resolution images from storage by converting them to low resolution images and places the low resolution images in the user's low resolution image collection); and

a storage recording unit which records the plurality of photographic image data sets determined to be expired from storage by the image storage expiration unit onto a storage recording medium which can be returned to the customers (see [0068], lines 22-37 – when the ordering period expires, the high resolution files are transferred back to the user computer and stored thereon).

Referring to claim 2, McIntyre et al disclose the image management device according to claim 1, wherein the image receiving unit determines whether a received photographic image data set, from among the plurality of received photographic image data sets, has been already received before, based on additional information [content identifiers] attached to the photographic image data set, and receives only photographic image data sets which have not been received yet (see [0076], lines 9-28 – the receiving unit checks to see which data has not yet been received by automatically checking the user database).

Referring to claim 3, McIntyre et al disclose the image management device according to claim 1, wherein the image receiving unit [service provider 80] transfers and stores the plurality of received photographic image data sets in the image storage unit [relational database 88] (see [0060], lines 16-19) through a network [communication network 50] (see [0052], lines 2-6).

Referring to claim 4, McIntyre et al disclose the image management device according to claim 1, wherein the image storage expiration determining unit [service provider 80] determines storage expiration for each pre-classified photographic image data group [data group] (see [0068], lines 22-37 – the service provider decides whether the ordering period has expired, and if it has then converts high resolution images into low resolution images).

Referring to claim 5, McIntyre et al disclose the image management device according to claim 1, wherein the storage recording unit records the plurality of photographic image data sets onto the storage recording medium so that associated photographic image data sets can be reproduced, by: associating the plurality of photographic image data sets; designating a representative photographic image data set from among the associated plurality of photographic image data sets; and selecting the representative photographic image data set during reproduction (see [0052]).

Referring to claim 6, McIntyre et al disclose the image management device according to claim 1, wherein the storage recording unit associates and records photographic image data sets and additional information, related to the photographic image data sets, onto the storage recording medium (see [0054] and [0068], lines 22-37 – the service provider decides whether the ordering period has expired; and if it has then converts high resolution images into low resolution images).

Referring to claim 7, McIntyre et al disclose the image management device according to claim 1, wherein the image storage unit [removable storage drive 14 which is connected to user computer 10] stores the plurality of photographic image data sets,

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which have been recorded onto the storage recording medium, for a predetermined period of time in a state where the customers cannot access the plurality of photographic image data sets, and thereafter, deletes the plurality of photographic image data sets from the image storage unit ([0070] – the images are temporarily stored until they can be transferred).

Referring to claim 8, McIntyre et al disclose the image management device according to claim 1, further comprising a printing unit which prints an index print of the plurality of photographic image data sets when the plurality of photographic image data sets are recorded onto the storage recording medium (see [0067]).

Referring to claim 9, McIntyre et al disclose the image management device according to claim 8, wherein the printing unit includes selecting means for selecting desired photographic image data sets from among the plurality of photographic image data sets recorded onto the storage recording medium, and the index print is created for only the photographic image data sets selected by the selecting means (see [0066]-[0067]).

Referring to claim 10, McIntyre et al disclose the image management device according to claim 1, further comprising a checking unit [service provider 80] for checking customer data recorded in the storage recording medium against the customer data stored along with the image data sets accumulated in the image storage unit, when additional image data sets are to be recorded into the storage recording medium in which image data sets of a predetermined customer are already stored by the storage recording unit; wherein the storage recording unit records the image data sets for which

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the customer data checked by the checking unit match, in the storage recording medium (see [0054] – the device can automatically check to see if new information is in the user database by comparing metadata that is attached to the image; the metadata includes customer account information).

Referring to claim 11, McIntyre et al disclose an image management system which connects user terminals [user computer 10] and an image management device [service provider 80] through a network [communication network 50] (see [0052], lines 2-6), in which the image management device has an image storage unit [removable storage drive 14 which is connected to user computer 10] which accumulates and stores a plurality of photographic image data sets [digital still images] (see abstract; [0052], lines 2-6; and [0053], lines 13-26);

an image receiving unit [service provider 80] which receives the plurality of photographic image data sets from customers [user low resolution image collection] and stores the plurality of photographic image data sets (see [0054], lines 7-12) in a state accessible to the customers, along with customer data related to the customers [user identifier] (see [0054], lines 13-21);

an image storage expiration determining unit [service provider 80] which determines whether to expire from storage the plurality of photographic image data sets accumulated and stored in the image storage unit (see [0068], lines 22-37 – the service provider decides whether the ordering period has expired, and if it has, the service provider then expires the high resolution images from storage by converting them to low

resolution images and placing the low resolution images in the user's low resolution image collection); and

a storage recording unit which records the plurality of photographic image data sets determined to be expired from storage by the image storage expiration unit onto a storage recording medium (see [0068], lines 22-37 – when the ordering period expires, the high resolution files are transferred back to the user computer and stored thereon);

wherein the image storage expiration determining unit includes storage expiration notifying means for notifying the user terminals of storage expiration of the plurality of photographic image data sets, which have been determined to be expired (see [0068], lines 22-37 – the user's terminal is notified that the order period has expired by placing the image files in the users low resolution image collection).

Referring to claim 12, McIntyre et al disclose the image management system according to claim 11, wherein the storage expiration notifying means further notifies the user terminals of customers who have permission to view the plurality of photographic image data sets, of storage expiration of the plurality of image data sets which have been determined to be expired (see [0069] – if the other users are registered, then they also will automatically receive the expired images in their low resolution image collection).

Referring to claim 13, McIntyre et al disclose an image management system as defined in claim 11, wherein the storage recording unit records onto the storage recording medium via a network (see [0068], lines 29-32; [0052], lines 2-6; and Fig 1, item 50 – the images are automatically placed in the user's low resolution image

collection; the service provider and the user computer communicate through the network).

Referring to claim 14, McIntyre et al disclose an image management system as defined in claim 12, wherein the storage recording unit records onto the storage recording medium via a network (see [0069], lines 12-15; [0052], lines 2-6; and Fig 1, item 50).

Referring to claim 15, McIntyre et al disclose an image management system which connects a plurality of image management devices through a network (see abstract and [0052], lines 2-6), in which the image management device has an image storage unit [removable storage drive 14 which is connected to user computer 10] which accumulates and stores a plurality of photographic image data sets [digital still images] (see [0053], lines 13-26);

an image receiving unit [service provider 80] which receives the plurality of photographic image data sets from customers [user low resolution image collection] and stores the plurality of photographic image data sets (see [0054], lines 7-12) in a state accessible to the customers, along with customer data related to the customers [user identifier] (see [0054]);

an image storage expiration determining unit which determines whether to expire from storage the plurality of photographic image data sets accumulated and stored in the image storage unit (see [0068], lines 22-37 – the service provider decides whether the ordering period has expired, and if it has, the service provider then expires the high

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resolution images from storage by converting them to low resolution images and places the low resolution images in the user's low resolution image collection); and

a storage recording unit which records the plurality of photographic image data sets determined to be expired from storage by the image storage expiration unit onto a storage recording medium; wherein the plurality of photographic image data sets have attached thereto storage information, which specifies a predetermined storage location of the photographic image data for a digital camera or the customers (see [0068], lines 22-37 – when the ordering period expires, the high resolution files are transferred back to the user computer and stored thereon); and

the image receiving unit transfers the plurality of photographic image data sets to a predetermined image management device according to the storage information of the plurality of received photographic image data sets and stores the plurality of photographic image data sets in the image storage unit of the image management device (see [0054] and Fig 1, item 80; and [0068], lines 22-37).

Referring to claim 16, McIntyre et al disclose the image management system according to claim 15, wherein: the image storage expiration determining unit includes storage expiration notifying means for notifying the user terminals of storage expiration of photographic image data sets determined to be expired (see [0068], lines 22-37 – the user's terminal is notified that the order period has expired by placing the image files in the users low resolution image collection).

Referring to claim 17, McIntyre et al disclose the image management system according to claim 16, wherein the storage expiration notifying means further notifies the

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user terminals of customers who have permission to view the plurality of photographic image data sets, of storage expiration of the plurality of image data sets which have been determined to be expired (see [0069] – if the other users are registered, then they also will automatically receive the expired images in their low resolution image collection).

Referring to claim 18, McIntyre et al disclose the image management system according to claim 16, wherein the storage recording unit records onto the storage recording medium via a network (see [0068], lines 29-32; [0052], lines 2-6; and Fig 1, item 50 – the images are automatically placed in the user's low resolution image collection; the service provider and the user computer communicate through the network).

Referring to claim 19, McIntyre et al disclose the image management system according to claim 17, wherein the storage recording unit records onto the storage recording medium via a network (see [0069], lines 12-15; [0052], lines 2-6; and Fig 1, item 50).

Referring to claim 22, McIntyre et al disclose the device of claim 1, wherein the expiration determining unit [service provider 80] expires image data sets based on an amount of time [ordering period] said image data sets were stored to the image storage unit (see [0068], lines 22-26).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 20030009569 to McIntyre et al as applied to claim 1 above, and further in view of US Patent No 7,016,868 to McIntyre et al (hereafter Pat '868).

Referring to claim 20, McIntyre et al disclose a storage recoding unit. However, McIntyre et al fail to explicitly disclose the further limitation wherein the storage recording medium comprises a portable storage medium. Pat '868 also discloses a storage recording unit [fulfillment center 86] which records the plurality of photographic image data sets determined to be expired [expired after a time period of one year] (see column 9, lines 49-54) from storage by the image storage expiration unit [network photoservice provider 34] onto a storage recording medium [CD] which can be returned to the customers [shipped to the customer] (see column 7, lines 61-65), including the further limitation wherein the storage recording medium comprises a portable storage medium [CD] (Pat '868: see column 7, lines 61-65) in order to have a way in which to easily provide a user with a backup copy of the images discarded from storage located at the service provider.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the feature of a portable storage unit as disclosed by Pat '868 as the storage recording medium disclosed by McIntyre et al. One would have been motivated to do so in order to have a way in which to easily provide a user with a backup copy of the images discarded from storage located at the service provider, which provides the user with the ability of restoring high resolution images at the user computer (PGPub '569: see [0014]).

Referring to claim 21, McIntyre et al disclose a storage recoding unit. However, McIntyre et al fail to explicitly disclose the further limitation wherein the storage recording medium comprises one of an optical disk, a magnetic recording device and a memory stick. Pat '868 also discloses a storage recording unit [fulfillment center 86] which records the plurality of photographic image data sets determined to be expired [expired after a time period of one year] (see column 9, lines 49-54) from storage by the image storage expiration unit [network photoservice provider 34] onto a storage recording medium [CD] which can be returned to the customers [shipped to the customer] (see column 7, lines 61-65), including the further limitation wherein the storage recording medium comprises one of an optical disk [CD] (Pat '868: see column 7, lines 61-65), a magnetic recording device and a memory stick in order to have a way in which to easily provide a user with a backup copy of the images discarded from storage located at the service provider.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the feature of an optical disk as disclosed by Pat '868 as the

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storage recording medium disclosed by McIntyre et al. One would have been motivated to do so in order to have a way in which to easily provide a user with a backup copy of the images discarded from storage located at the service provider, which provides the user with the ability of restoring high resolution images at the user computer (PGPub '569: see [0014]).

Response to Arguments

8. Applicant's arguments filed 22 June 2006 have been fully considered but they are not persuasive.

Referring to applicants' remarks on page 10 regarding the Section 102 rejection of claims 1, 11 and 15: Applicant argues that McIntyre does not disclose or suggest at least a storage recoding unit which records the plurality of photographic image data sets determined to be expired from storage by the image storage expiration unit onto a storage recoding medium which can be returned to the customers, as recited in claim 1.

The examiner respectfully disagrees. McIntyre et al disclose this limitation in [0068], lines 22-37. The applicant continues to argue that McIntyre et al does not store images in a manner that allows them to be returned to the user after the storage period expires and that McIntyre et al converts the images to low resolution images before storage. Regarding the argument of returning the storage medium to the user, the claim states "a storage recording medium which can be returned to the customer," and any storage recording medium has the ability of being transported to another even though it might not be practical. Regarding, the conversion of images to low resolution images,

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this further feature of McIntyre et al does not negate the applicants' claimed invention and therefore is not relevant.

Referring to applicants' remarks on page 11 regarding the Section 102 rejection of claims 11: Applicants argue that the only notification provided by the disclosure of McIntyre is the lack of availability when a user attempts to access the images. Therefore, as applied by the Examiner, McIntyre provides no disclosure of express notification of the expiration of a storage period for the photographic image data sets, as recited by claim 11.

The examiner agrees, however, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., express notification of the expiration of a storage period) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Lovel whose telephone number is (571) 272-2750. The examiner can normally be reached on 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kimberly Lovel
Examiner
Art Unit 2167

8 September 2006
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